

REMARKS

Claims 1-20 are currently pending in the subject application and are presently under consideration. Claims 1-5, 7-10, 13-14 and 20 have been amended as shown on pp. 2-5 of the Reply.

Applicants' representative thanks the Examiner for the courtesies extended during the teleconference of March 20, 2007.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-20 Under 35 U.S.C. §101

Claims 1-20 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Independent claims 1, 14 and 20 have been amended herein to clearly illustrate that elements within such claims are components associated with a computer processor. In particular, claim 1 as amended is directed towards a system, the system is recorded on a computer-readable medium and capable of execution by a computer, comprising an annotation management component and a navigation component. (Support for these amendments can be found on pg. 6, lines 1-9). Accordingly, this claim includes functional descriptive material rendering it structurally and functionally interrelated to the computer processor and is therefore directed to statutory subject matter. Furthermore, claims 14 and 20 have been similarly amended. Accordingly, this rejection should be withdrawn.

II. Rejection of Claims 1-20 Under 35 U.S.C. §112, first paragraph

Claims 1-20 stand rejected under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement. The Examiner states that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1-20 have been amended to correct any deficiencies related to this rejection, as such the rejection is moot and should be withdrawn.

III. Rejection of Claims 1-20 Under 35 U.S.C. §112, second paragraph

Claims 1-20 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-20 have been amended to correct any deficiencies related to this rejection, as such the rejection is moot and should be withdrawn.

IV. Rejection of Claims 1-2, 4-16 and 18-20 Under 35 U.S.C. §103(a)

Claims 1-2, 4-16 and 18-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Marshall *et al.* (US 2003/0070139) in view of Nagae (US Patent 6,230,169). It is respectfully requested that this rejection should be withdrawn for at least the following reasons. Marshall *et al.* and Nagae, individually or in combination, do not teach or suggest each and every element as set forth in the subject claims.

To reject claims in an application under §103, an examiner must show an un rebutted *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicants' disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants' claimed subject matter relates to systems and methods that facilitate annotating digital documents (*e.g.*, word processing documents, images, *etc.*) displayed by microprocessor-based devices such as desktop computers, Tablet PCs, PDAs, cell phones, and the like. The systems and methods provide a focus plus context-based interface that enables multi-scale navigation during document annotation. This interface zooms a region of an underlying document, wherein a user can enter annotations in the region at a size comfortable to the user and suitably scaled to the device display. More particularly, independent claims 1, 14 and 20 recite similar limitations, namely: a system that facilitates free form digital inking, comprising: *an annotation management component that generates an inking region for a digital*

document; and a navigation component that provides algorithms that enable manual and automatic re-positioning and re-sizing of the inking region relative to the digital document, the re-positioning and re-sizing of the inking region occurs prior to, concurrently with and after a user annotates the digital document. The cited art, individually or in combination, fails to teach or suggest such aspects of the claimed invention.

Marshall *et al.* discloses systems and methods that detect and emphasize high-value freeform annotations. The particular annotation style used by a particular user to create the annotations in a document is determined. This annotation style can be individual or a standardized style. Once the annotation style is determined, such that high-value annotation marks can be distinguished from low-value annotation marks, the annotations within the document are analyzed to locate the high-value annotation marks. (See pg. 1, paragraphs [0011]-[0014]).

In contrast, applicants' claimed system facilitates annotating digital documents displayed by microprocessor-based devices such as desktop computers, Tablet PCs, PDAs, cell phones, and the like. The system provides a focus plus context-based interface that enables multi-scale navigation during document annotation. The Examiner states that Marshall *et al.* is silent with regard to an annotation window for freeform annotation using digital inking. (See Office Action dated 2-6-07, pg. 7).

Nagae does not make up for the aforementioned deficiencies of Marshall *et al.* with respect to independent claims 1, 14 and 20 (which claims 2, 4-13, 15, 16 and 18-19 respectively depend there from). Nagae relates to a data processing apparatus with annotation display function that enables the user to check the contents of annotations while reading the text, by reducing or enlarging the display image of an annotation input widow with a specified magnification in displaying annotations and by superposing the display imagine in a specified position on a text display image on a text display screen. (See col. 1, lines 42-49).

Whereas, applicants' claimed subject matter provides a focus plus context-based interface that enables multi-scale navigation during document annotation. The system includes a navigation component that provides algorithms that enable manual and/or automatic re-positioning and/or re-sizing relative to the document in order to allow the user to add annotations essentially anywhere on the document. Such re-positioning and/or re-sizing can occur prior to, concurrently with or after annotating; thus, the presently claimed subject matter provides for

multi-scale navigation before, during and after annotating. The algorithms are based on a space-scale framework and include a create space, a move inking region, and a move document algorithm. The space-scale framework is based on geometric relationships between the inking region and the document being annotated. (See pg. 10, lines 18-25).

Nagae merely discloses prompting a user to enter an annotation on a window with a coordinate input device, such as a table, reduce or enlarge the display image of the window with a specified magnification, and then display the window again. Nagae does not disclose manual and/or automatic re-positioning and/or re-sizing relative to the document. Accordingly, Nagae is silent with regard to *...a navigation component that provides algorithms that enable manual and automatic re-positioning and re-sizing of the inking region relative to the digital document, the re-positioning and re-sizing of the inking region occurs prior to, concurrently with and after a user annotates the digital document.*

In view of the aforementioned deficiencies of the cited art, it is respectfully submitted that this rejection be withdrawn with respect to independent claims 1, 14 and 20 (and claims 2, 4-13, 15, 16 and 18-19 which depend respectively there from).

V. Rejection of Claims 3 and 17 Under 35 U.S.C. §103(a)

Claims 3 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Marshall *et al.* in view of Nagae and N.O. Bouvin *et al.*, “Fluid Annotations Through Open Hypermedia: Using and Extending Emerging Web Standards”. Proceedings of the 11th International Conference on World Wide Web, May 7-11, 2002, Honolulu, Hawaii, Pages 160-171, (Hereinafter Bouvin). It is respectfully submitted that this rejection should be withdrawn for the following reasons. Marshall *et al.*, Nagae, and Bouvin, individually or in combination, do not teach or suggest each and every element set forth in the subject claims. In particular, Bouvin does not make up for aforementioned deficiencies of Marshall *et al.* and Nagae with respect to independent claims 1 and 14 (which claims 3 and 17 depend respectively there from). Thus, the claimed subject matter as recited in claims 3 and 17 is not obvious over the combination of Marshall *et al.*, Nagae and Bouvin. Therefore, it is respectfully submitted that this rejection be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP592US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN, TUROC & CALVIN, LLP

/Marisa J. Zink/

Marisa J. Zink

Reg. No. 48,064

AMIN, TUROC & CALVIN, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731